AMENDMENTS TO THE DRAWINGS:

A new Figure 7 has been added to show the air-root-pruning region includes protuberances having outwardly extending distal ends that are open. Support for this new figure is drawn from the detailed description (especially paragraph 23), as well as Figures 1-4, 6 and the discussions thereof (paragraphs 15-20 and 38-43). Paragraph 23 includes an incorporation-by-reference of the subject matter of copending application 10/446,987. Paragraph 23 specifically refers to this incorporated reference as describing:

> bendable sheets having protuberances for air-root pruning and the sheets are sufficiently flexible to be bent and secured into a cylindrical shape for use as a container sidewall. In accordance with the present embodiment of the invention, a portion of the protuberances may have the outwardly extending distal end closed to form a root-tip-trapping region in combination with a region of open-ended air-root-pruning protuberances. Furthermore, the root-tip-trapping region could be formed with or without the protuberances by bonding a suitable porous fabric material to the inside surface of the sheet.
>
> (Paragraph 23, lines 9-15; emphasis added)

Figure 7 is a cross-section side view consistent with Figures 1-4 and 6 of the present application, as well as Figure 5B of 10/446,987. Figure 7 has been constructed in accordance with the explicit statements of paragraph 23 to show a container sidewall 17 made from a bendable sheet 16 having a root-tip-trapping region 13 formed by bonding a suitable porous fabric 18 to the inside surface of the sheet 16 in combination with an air-root-pruning region 20 having open-ended protuberances. No new matter has been added to the specification as a result of this new Figure.

REMARKS/ARGUMENTS

The drawings stand objected to under 37 CFR 1.83(a) because the drawings failed to show every feature of the invention specified in the claims. Figure 7 has been added to illustrate an air-root-pruning region that includes protuberances having outwardly extending distal ends that are open. Support for Figure 7 is described in the above section AMENDMENTS TO THE DRAWINGS. New paragraph [0043.1] describes Figure 7 and is similarly supported. Accordingly, Applicant asserts that no new matter has been entered.

Claim 36 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, Figure 1 of the present application illustrates a container 10 having a sidewall 17 comprising a root-tip-trapping region 13 and a porous fabric region 20 that enables air-root-pruning. (Specification, para. 38, lines 2-3; Figure 1). Having clearly established how these regions are made, Applicant asserts that there is nothing indefinite about arranging these regions into a pattern as claimed.

Furthermore, the specification includes a description of how patterns may be provided:

> [0008] The present invention provides a sidewall for a plant container and a plant container incorporating the sidewall. The sidewall comprises a root-tip-trapping region, such as a bilayer material described below, and an air-root-pruning region, wherein the regions are combined to form the sidewall. The root-tip-trapping and air-root-pruning regions may be configured in various patterns such as rows, columns, dots, checkerboard and the like. However, the most preferred configuration has the root-tip-trapping region forming a continuous upper portion of the sidewall and the air-root-pruning region forming a lower portion of the sidewall. Preferably, the root-tip-trapping region will form the upper half of the container. Most preferably, the root-tip-trapping region will form between 2/3 and 3/4 of the sidewall.

Reconsideration and withdrawal of the rejection is requested.

Claims 1-4, 7, 11, 12, 20, 26, 27, 37-40 and 46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al. (US 3,080,680). Reynolds '680 discloses a organic fibre pot, particularly a pot comprising predominately peat moss, that is strengthened by applying a removable plastic coating, skin or enrobement to the outside of the pot. (Reynolds, col. 2, lines 40-46). Applicant asserts that Reynolds does not anticipate the claimed invention.

In *W. L. Gore 7 Associates v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984), the Federal Circuit stated that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." The Federal Circuit has indicated that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating references.

Further, "[u]nder 35 U.S.C. §102, anticipation requires that... the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public." Akzo N.V. v. U.S. Int'l Trade Comm'n, 808 F.2d 1471 (Fed. Cir. 1986). The Federal Circuit has added that the anticipation determination is viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention." Scripps Clinic & Research Found. V. Genentech Inc., 927 F.2d 1565 (Fed. Cir. 1991).

Similarly, the Federal Circuit has stated that "[a]n anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention." ATD

Corp v. Lydall, Inc. 159 F.3d 534 (Fed. Cir. 1998).

For example, claim 1 of the present application includes a "root-tip-trapping region." The present application describes two types of root-pruning elements, root-tip-trapping and air-root-pruning. (Specification, para. 7). Figures 4 and 6, and the discussions of those Figures (Specification, para. 41 and 43), are dedicated to describing the phenomena of root-tip-trapping.

Furthermore, Whitcomb (U.S. Patent 4,442,628) describes a "root-pruning structure" including "root traps" whereby "the tip of the roots" becomes trapped. Root tips become trapped in the '628 stair stepped container structure such that "physical restriction to further elongation of the root caused branching to occur much like air-root-pruning." In U.S. Patent 6,202,348 (cited by the Examiner), Reiger characterizes Whitcomb '628 similarly, saying that "[r]oot tips of plants grown in such pots may be trapped in the corners of the stair step root pruning structure, so that the roots lose their apical dominance and begin to branch in the pot." (Reiger, col. 2, lines 60-65). Accordingly, one of ordinary skill in the art would understand the meaning of a "root-tip-trapping region" consistent with both the present application and the references in the prior art that deal with trapping root tips.

Reynolds (U.S. Patent 3,080,680) does not expressly or inherently disclose a root-tip-trapping region. In a discussion of the "enrobements" covering his pots, Reynolds states that the enrobements:

> "deflect roots which penetrate the pot wall, and cause them to continue to grow in the inter-face between the pot and the skin. Thus, the roots are there and ready to grow out into the soil the moment the external film is removed and the plant transplanted." (Reynolds, col. 3, lines 20-25).

Reynolds goes on later to say:

> "as plants grow in the pots, rootlets will force their way through the walls of the pot, just as they do in the use of conventional fibrous pots, and that the degree of adherence of the enrobement to the pot is such that the rootlets can continue to grow in the interface between the skin and the pot, but will not force their way through the skin." (Reynolds, col. 5, lines 66-73).

Clearly, Reynolds does not disclose any structure that possesses the claimed characteristic of a root-tip-trapping region.

While the Examiner has asserted that Reynolds teaches a root-tip-trapping region, citing "the fibrous walls of the pot 18 and the sheet 60, col. 5, lines 5-8, 38-42, 65-75" (Office Action, page 3, para. 6), Applicant has shown that there is no such disclosure. In fact, Reynolds expressly teaches, as shown above, that the structure disclosed would not trap root tips as claimed by Applicant. Therefore, Reynolds does not establish that the claimed subject matter existed prior to the present invention by the Applicant.

Similarly, Reynolds does not expressly or inherently disclose any structure that possesses the claimed characteristic of an air-root pruning region. Reynolds states that "the enrobement which is thus produced effectively strengthens the relatively fragile pot to protect it against damage in ordinary handling, and that the skin will effectively adhere to the pot throughout normal handling, plunging and the like." (Reynolds, col. 5, lines 61-65). Reynolds defines "plunging" as immersing the plant's roots, together with the container, in soil or other media in which growth would occur if the plant were not restrained by the container. (Reynolds, col. 2, lines 20-23). Accordingly, the structure disclosed by Reynolds does not air-root prune because the plastic enrobement would not be air permeable, and also because the pot is intended to be plunged, i.e., planted into the soil, so that the pot is surrounded by soil that would not cause air-root pruning.

The Examiner asserts that the bottom of sheet 60 is perforated, thus allowing air to enter adjacent to the root-tip-trapping region. (Office Action, page 3, para. 6). However, the bottom

of the sheet would generally be either plunged in soil or sat onto a support surface such that air-root-pruning would not occur. Applicant asserts that Reynolds does not expressly teach air-root-pruning and that a finding of inherent anticipation is not supported unless missing elements are necessarily present in the thing described by the reference. A person having ordinary skill would not read Reynolds as teaching air-root-pruning.

Furthermore, the claims subject to this rejection are all directed to a sidewall for a plant container. Discussing Figure 2, the specification states that "[s]eams **19** are shown coupling a floor or bottom **15** to the sidewalls **17** of the barrier to form the container **10**." (Specification, paragraph 39; Figure 2). Accordingly, a sidewall is an element of a container that is distinct from the bottom of the container. Reynolds makes a similar distinction between the bottom wall **17** of the pot and the side walls **16** of the pot. (Reynolds, col. 5, lines 25-28).

Still further, Reynolds does not expressly or inherently disclose any structure that possesses both a root-tip-trapping region and an air-root-pruning region in the same sidewall for a plant container as claimed. For example, an embodiment shown in Figure 1 of the present application illustrates a container 10 having a sidewall 17 comprising a root-tip-trapping region 13 and a porous fabric region 20 that enables air-root-pruning. (Specification, para. 38, lines 2-3; Figure 1). In Figure 1, the root-tip-trapping region 13 includes an inner layer of porous fabric 18 laminated with an outer layer of a nonporous, root-impenetrable material 16. (Specification, para. 38, lines 3-5; para 39, lines 2-4; Figure 1). Accordingly, a region of the sidewall may have one or more layers. As shown in Figure 2, the root-tip-trapping region 13 may be a laminate of two layers, wherein the layer of porous fabric 18 extends beyond the root-impenetrable material 16 to form the sole layer of the air-root-pruning region 20.

For all of the reasons stated above, reconsideration and withdrawal of the rejection is requested.

Claims 5, 6, 8, 9, 14-16, 24, 32, 33, 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above). Applicant has shown above that Reynolds does not teach, show or suggest root-tip-trapping, air root pruning, or a combination of the two. In the absence of a suggestion to so modify the disclosure of Reynolds, Reynolds does not make claim 1 obvious, nor any of the claims ultimately dependent from claim 1.

Reconsideration and withdrawal of the rejection is requested.

Claims 10, 13, 17-19, 47-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Reiger (US 6202348). The Examiner has not expressly stated any evidence to support a motivation to combine Reynolds and Reiger. These references address quite different problems and Applicant finds no such motivation or suggestion to combine these references.

In addition, there is nothing in Reynolds, Reiger or a combination thereof that teaches, shows or suggests a container having both a root-tip-trapping region and an air-root-pruning region, as claimed.

Regarding claims 10 and 13, Applicant would point out that Reiger '348 does not disclose protuberances. Element 160 is disclosed by Reiger as the inner surface of a fabric liner. Reiger never uses the term protuberance and the structures disclosed are not protuberances at all. On the other hand, protuberances are described in U.S. Patent 4,939,865 and copending U.S. patent application 10/446,987. Accordingly, a person of ordinary skill in the art would understand the term protuberance to mean something that thrusts outwardly from a surrounding or adjacent surface. (See 10/446,987, first paragraph of the Summary).

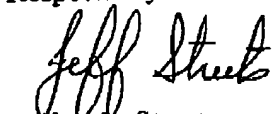
Reconsideration and withdrawal of the rejection is requested.

Various dependent claims stand rejected under 35 U.S.C. 103(a) based on Reynolds et al. (as above) in view of one or more other secondary references. These rejections include: Claim 21 stands rejected as being unpatentable over Reynolds et al. (as above) in view of Thomas (US 5311700); Claims 22 and 23 stand rejected as being unpatentable over Reynolds et al. (as above) in view of Berlit et al. (GB 2073567); Claims 25, 29 and 31 stand rejected as being unpatentable over Reynolds et al. (as above) in view of Van der Goorbergh (EP 300578A3); Claims 28, 34 and 35 stand rejected as being unpatentable over Reynolds et al. (as above) in view of Flasch, Jr. (US 5852896); and Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. as modified by Berlit et al. as applied to claims 1,3,22 above, and further in view of Flasch (as above). However, Reynolds does not teach, show or suggest root-tip-trapping. Similarly, none of these secondary references teach, show or suggest root-tip-trapping, either. Accordingly, none of these combinations of references renders the claimed invention obvious.

Reconsideration and withdrawal of these rejections is requested.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0002.A of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



Jeffrey L. Streets
Attorney for Applicant
Registration No. 37,453
STREETS & STEELE
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713) 939-9444

Customer No. 24945